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This is a decision in response to applicants' PETITION TO ACCEPT UNINTENTIONALLY DELAYED CLAIM UNDER 37 C.F.R. 1.78(a)(6) filed 03 October 2003 and the amendment filed on the same date.

BACKGROUND

Applicants filed international application PCT/EP01/05254 on 07 May 2001. This application designated the United States of America (US) and claimed the priority of EP 00201702.8, filed on 12 May 2000. The 20 month time limit for national stage filing in the US expired at midnight on 14 January 2002 (12 January 2002 was a Saturday). Applicants filed the requisite basic national filing fee on 08 January 2002.

Applicants were granted a 35 U.S.C. 371(c) (1), (2) and (4) date of 08 January 2002 and the application was forwarded to the US examining corps for action on the merits. The examiner issued an office action on 03 July 2003 in which applicants were advised that they has “not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) or 120.”

Specifically, applicants were advised that "An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application in the first sentence of the specification of(sic, "or") in an application data sheet (37 CFR 1.78(a)(2))

and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.”

Applicants were also required in this office action to provide a “new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date. . . .” The oath or declaration was defective because “It does not identify the foreign application for patent or inventor’s certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.”

In response to this office action, applicants filed on 03 October 2003 the instant petition under 37 CFR 1.78(a)(6) and an amendment requesting that a statement be placed before the first line of the specification indicating that “This application is the U.S. national phase of International Application PCT/EP01/05254 filed May 7, 2001.”

DISCUSSION

37 CFR 1.78(a)(6) provides for the acceptance in a later-filed nonprovisional application of an unintentionally delayed claim for priority under 35 U.S.C.119(e) to a prior-filed U.S. provisional application when the claim is not presented in the later-filed nonprovisional application within the time period provided for in 37 CFR 1.78(a)(5)(ii).

The two applications which applicants are concerned with herein are PCT/EP01/05254 and EP 00201702.8 –neither of which is a provisional application.

Re: PCT/EP01/05254

PCT/EP01/05254 is an international application which designated the United States of America. Applicants are not seeking to add a priority claim to this application -- rather they seek to add an amendment before the first line of the specification indicating that the instant application is the national phase of international application PCT/EP01/05254.

It is not necessary for applicants to make the above-noted amendment before the first line of the specification. The instant application has been identified from the beginning as the national stage (phase) of PCT/EP01/05254. In these circumstances, there is no priority claim possible between the instant application and PCT/EP01/05154. Indeed, the instant application and PCT/EP01/05254 (in regards to the US designation therein) are regarded as one and the same application, and share the same filing date, 07 May 2001 (See 35 U.S.C. 363).

This relationship was officially noticed by the United States Patent and Trademark Office (USPTO) in the NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) mailed on 24 October 2002. In addition, this relationship was specified in the Official Filing Receipt mailed to applicants with the Form PCT/DO/EO/903.

Clearly in the instant application, no petition or amendment is necessary to claim the benefit of PCT/EP01/05254 because no such benefit claim is possible. If applicants wish to add the language quoted above from the 03 October 2003 amendment before the first line of the specification, there is no reason to prevent entry of the amendment since it does nothing more than state the recognized relationship of the instant application to PCT/EP01/05254.

RE: EP 00201702.8

Applicants are also attempting to receive benefit under 35 U.S.C. 119(a) of EP 00201702.8. As noted above, the 03 July 2003 office action required a new oath or declaration because the existing declaration did not identify EP 00201702.8 as a document for which foreign priority was being claimed.

Applicants have not presented any amendment to claim the priority of EP 00201702.8 and, as noted above, this application is clearly not a US provisional application. Therefore, the provisions of 37 CFR 1.78(a)(6) do not apply to any such priority claim for the benefit of EP 00201702.8.

It is noted that the oath or declaration filed on 08 January 2002, was a "Declaration of inventorship (PCT Rules 4.17(iv) and 51bis.1(a)(iv)) for the purposes of the designation of the United States of America." This declaration is used as part of the Request (Form PCT/RO/101). The declaration in question was included as part of the Request form filed with PCT/EP01/05254. The instant application contains a copy of sheets 1 – 9 of this Request form. Sheets 7 and 8 constitute the oath or declaration required by 35 U.S.C. 371(c)(4) for this international application to enter the US national phase.

This declaration states "I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority. . ." The Request form in Box VI on page 5 indicates a claim to European Patent application 00201702.8, filed on 12 May 2000. This declaration is acceptable for applications entering the US national stage. Thus the declaration has a proper claim for the benefit of the foreign application.

Clearly, no amendments, or petitions are necessary for applicant to claim the benefit under 35 U.S.C. 119(a) or 37 CFR 1.55 of EP 00201702.8.

DECISION

For the reasons discussed above, applicants' PETITION TO ACCEPT UNINTENTIONALLY DELAYED CLAIM UNDER 37 C.F.R. 1.78(a)(6) filed 03 October 2003 is **DISMISSED** as moot.

A corrected Filing Receipt accompanies this decision. This Filing Receipt indicates that the instant application is the national phase of PCT/EP01/05254 filed on 07 May 2001 and indicates a foreign priority claim to EP 00201702.8 filed on 12 May 2000.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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Inc: corrected Filing Receipt